**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Patent Application of: | ) | Examiner: Duyen My Doan |
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| Satoshi Nakajima | ) | Art Unit: 2452 |
| | ) | |
| Application No.: 10/082,601 | ) | Confirmation No. 5731 |
| | ) | |
| Filed: February 22, 2002 | ) | |
| | ) | |
| For: AUTONOMOUS RENDERING OF EMAIL ATTACHMENTS | ) | |
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Mail Stop Appeal
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REVIEW REQUEST**

Dear Sir:

This Notice of Appeal and the Pre-Appeal Brief Review Request are submitted in response to the Final Office Action mailed September 18, 2008.

In the subject Final Office Action, claims 7-12, 14-15, 18-20, 27-31, 33-35 and 38-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,272,484 (hereinafter Martin) in view U.S. Patent Application No. 2002/0059347 (hereinafter Shaffer). Claims 16-17 and 36-37 were rejected based on Martin, Shaffer and official notice that MIME is well know in the art.

In rejecting claims 7-12, 14-15, 18-20, 27-31, 33-35 and 38-40, the Examiner admitted that Martin does not teach identifying by a computing device a format of a binary file generated by a source application; selecting a set of user interface display specifications from a plurality of sets of interface display specification, based at least in part on the identified format of the binary file; each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display state.

However, the Examiner asserted that Shaffer, in particular, its teaching in para 25, remedies these deficiencies of Martin. Further, in responding to Applicant's last response, the Examiner re-asserted that the "transition rules are inherent."

Without addressing whether the Examiner's reading of Martin is correct, Applicant submits the Examiner's reading of Shaffer is clearly in error.

Shaffer in para 25 teaches the CPU 200 running the email application program may analyze the receive attachment file for a suffix. If such a suffix is provide, the program then will compare the application attachment file suffix with the stored table 213 of application document suffixes. If a match is found, the CPU 200 running the email application program will cause the corresponding application program to be opened. The application program begins running in a minimized condition. Then, when the user access the email message and clicks, for example, on the attachment icon, the application program is released from the minimized condition and automatically opens the attachment application file.

Applicant submits "launching a program in a minimized condition based on an attachment file suffix" does not teach or suggest "selecting a set of user interface display specifications from a plurality of sets of user interface display specifications, based at least in part on the identified format of the binary file." Even if we assume arguendo that because "launching a program in a minimized condition based on an attachment file suffix" results in different minimized application icons (e.g. a minimized Word icon or a minimized Excel icon), thus "launching a program in a minimized condition based on an attachment file suffix" may be read as "effectively causing rendering one of a plurality of user interface" (a reading Applicant disagrees), nonetheless, such "launching …" still cannot be read as "selecting a set of user interface display specifications from a plurality of sets of user interface display specifications." That is because the "launching ..." operation is from a plurality of available application programs, and NOT "from a plurality of sets of user interface display specifications" as required by claims 7 and 27.

Further, all subsequent displays after a user clicks on the minimized application icon, are based on the application's processing of attachment file. There are no transition rules that govern what the processing application displays. In particular, there are NO "associating results of said

processing of the binary file with the selected set of user interface display specifications …, wherein each user interface display specification includes one or more transition rules specifying one or more transitions to one or more other user interface displays specified by one or more other user interface display specifications" as required by claims 7 and 27.

Therefore, for at least the foregoing reasons, Applicant submits claims 7 and 27 are patentable over Martin and Schaffer combined under 35 U.S.C. §103(a).

Claims 8-12, 28-31 and 33 depend from claims 7 and 27, incorporating their recitations respectively. Therefore, due to at least the reasons stated above claims 8-12, 28-31 and 33 are also patentable over Martin in view of Shaffer under 35 U.S.C. §103(a).

In the Final Office Action, the Examiner rejected claims 15 and 35 based on the same ground for rejecting claims 7 and 27. However, claims 15 and 35 contain different recitations. In particular, claims 15 and 35 recite in substance

> "simulating, by the computing device, one or more user input signals based upon said selected set of one or more user interface display specifications; and
>
> capturing, by the computing device, output responses of the associated source application to said one or more user input signals, and associating the captured output responses with the selected set of user interface display specifications to generate a self-contained representation of said first attachment to allow subsequent viewing of the attachment independently of the associated source application."

In the last response, Applicant pointed out to the Examiner that neither Shaffer or Martin contains any teaching or suggestion for "simulating, by the computing device, one or more user input signals based upon said selected set of one or more user interface display specifications" or "capturing, by the computing device, output responses of the associated source application to said one or more user input signals, and associating the captured output responses with the selected set of user interface display specifications to generate a self-contained representation of said first attachment to allow subsequent viewing of the attachment independently of the associated source application".

In the Final Office Action, the Examiner never responded to Applicant's argument, and failed to even recognize the difference between claims 15 and 35, and claims 7 and 27.

Thus, for at least these reasons, the Examiner's rejections are clearly in error.

Finally, claims 16-17 and 36-37 depend from claims 15 and 35, incorporating their recitations respectively. Thus for at least the same reasons, claims 16-17 and 36-37 are patentable over the cited references.

## CONCLUSION

Applicant submits all pending claims are in condition for allowance. Issuance of the Notice of Allowance is respectfully requested. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,

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